-- REMARKS --

Reconsideration of all grounds of rejection in the Office Action, and allowance of all the pending claims are respectfully requested.

The Examiner has not yet officially withdrawn the previous objection to the drawings, and Applicants request the Examiner acknowledge that the objection to the drawings be withdrawn.

A. Claims 1-9 were rejected under 35 U.S.C.§103(a) as being unpatentable over Lin (U.S. Patent 6,346,933) in view of Koike (U.S. Patent 5,448,261).

The §103(a) rejection of claims 1-9 is traversed. Claims 1-9 were rejected under 35 U.S.C.§103(a) as being unpatentable over Lin in view of Koike. For this obviousness rejection to stand, each and every element of the claimed invention must be taught or suggested by the references. Because Lin in view of Koike does not teach or suggest a "control unit [that] detects the position of the hand-held device", Lin in view of Koike cannot render the instant application unpatentable.

At most, Lin teaches a control unit that recognizes the position of light emitted by the hand-held device on a projection screen. The Lin system operates using three pieces – a hand-held laser pointer, a projection screen, and the control system. See, Lin, column 3, lines 25-65. An operator uses the laser pointer to direct a laser beam onto the projection screen. The control system is pointed at the projection screen, and not the laser pointer. The control system then recognizes the laser light reflected by the projection screen and determines an appropriate action to take based on the reflected light.

Similarly, Koike does not teach or suggest a "control unit [that] detects the position of the hand-held device." Koike teaches that a control unit detects the position of the *cursor* on the display screen. See, e.g., Koike column 22, lines 21-25.

Thus, Lin in view of Koike does not teach the claimed invention, and indeed directly teaches away from claim 1. Claim 1 requires that the control unit detect the position of the *hand-held device*, rather than the position of a *light beam* emitted by the device. "In this manner, the projection of laser beam 15 onto presentation image 13 serves to control the display presentation...." Lin, column 6, lines 35-37. "The operating portion 104 finds coordinates (x, y) of the position of the cursor 00 on the display screen B ..." Koike, column 22, lines 21-22.

Furthermore, the mere fact that the reference *could* be modified to arrive at the claimed invention (which Applicants do not concede and actively dispute) is insufficient to prove a prima facie case. *See* MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While Applicants do not agree that the modification of the reference would result in the claimed invention, there must be some motivation or suggestion in the references to modify in order to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *See* Graham v. John Deere Co., 383 U.S. 1 (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness.

Indeed, in direct contravention of the strictures of 103(a), modifying the instant application in the fashion suggested by the Examiner would require significant redesign. Thus, the suggested modification of the reference destroys the intent, purpose or function of the invention disclosed in the reference. *See*, In Re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). Modifying the instant invention so that the control unit receives reflected light, rather than light directly from the hand-held unit destroys the intent, purpose, and function of the invention. And, even if the intent were not destroyed, modifying the invention as suggested by the

Examiner would require significant modification to the Applicants' invention and would require significant redesign – a requirement in direct contrast to the mandates of Section 103(a). *See*, In Re Ratti.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "... it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejection to claim 1 is requested. Withdrawal of the rejections to claims 2-9, depending directly or indirectly from claim 1 is also requested.

B. Claim 23 was rejected under 35 U.S.C. §103(a) as being anticipated by Rice (U.S. Patent 5,973,672) in view of Koike (U.S. Patent 5,448,261).

Claim 23 was rejected as unpatentable under §103(a) over Rice in view of Koike. This 103(a) rejection is traversed. For this obviousness rejection to stand, each and every element of the claimed invention must be taught or suggested by the references, alone or in combination. Because Rice in view of Koike does not teach or suggest a "control unit [that] detects the position of the hand-held device", Rice cannot render the instant application unpatentable.

Rice teaches an interface similar to Lin, using a camera to image points of light displayed on projection screen. The camera then delivers a video output representing the visible spots and a computer to process the images. See, Rice, Abstract.

Similarly, Koike does not teach or suggest a "control unit [that] detects the position of the hand-held device." Koike teaches that a control unit detects the position of the *cursor* on the display screen. See, e.g., Koike column 22, lines 21-25.

Just like Lin, however, the operation and analysis of the light is premised on the light reflected by the projection screen, and not premised on the location of the hand-held transmitter itself. The position of the hand-held unit is not determined, and instead, the position of the light emitted by the hand-held unit is determined.

Thus, Rice in view of Koike does not teach or suggest each and every limitation of claim 23 and teaches away from claim 23. Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "... it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Furthermore, the mere fact that the reference *could* be modified to arrive at the claimed invention (which Applicants do not concede and actively dispute) is insufficient to prove a prima facie case. *See* MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While Applicants do not agree that the modification of the reference would result in the claimed invention, there must be some motivation or suggestion in the references to modify in order to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *See* Graham v. John Deere Co., 383 U.S. 1 (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness.

Indeed, in direct contravention of the strictures of 103(a), modifying the instant application in the fashion suggested by the Examiner would require significant redesign. Thus, the suggested modification of the reference destroys the intent, purpose or function of the invention disclosed in the reference. *See*, In Re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). Modifying the instant invention so that the control unit receives reflected light, rather than light directly from the hand-held unit destroys the intent, purpose, and function of the invention. And, even if the intent were not destroyed, modifying the invention as suggested by the Examiner would require significant modification to the Applicants' invention and would require significant redesign – a requirement in direct contrast to the mandates of Section 103(a). *See*, In Re Ratti.

Withdrawal of the rejection to claim 23 is requested.

C. Claim 10 was rejected as unpatentable under 35 U.S.C. §103(a) over Lin and Koike in view of Kim

The §103(a) rejection of claim 10 over Lin and Koike in view of Kim is traversed.

Claim 10 depends from claim 1 and is therefore patentable over Lin in view of Kim for at least the same reasons. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)
Kim is cited for its teaching using an LED as a light source. This teaching, if present, would not cure the rejection however. Kim does not teach use of the LED with a "control unit [that] detects the position of the hand-held device." Thus, Lin and Koike in view of Kim does not teach or suggest each and every limitation of claim 10 and teaches away from claim 10.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to

provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejection to claim 10 is requested.

D. Claims 11-16 were rejected as unpatentable under 103(a) over Lin, Kim and Koike in view of Fitts

The 103(a) rejection of claims 11-16 as unpatentable over Lin, Kim and Koike in view of Fitts is traversed.

Claims 11-16 are dependent claims, depending directly or indirectly from claim 1, and are therefore patentable over Lin, Kim and Koike in view of Fitts for at least the same reason. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Fitts is cited for the teaching of two digital cameras with digitizers and processing of digital images. However, Fitts does not teach a "control unit [that] detects the position of the hand-held device" and therefore the references alone or in combination do not teach each and every element of the claims.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejections to claims 11-16 is requested.

E. Claims 17-21 were rejected as unpatentable under 35 U.S.C. §103(a) over Lin and Koike in view of Arita

The §103(a) rejection of claims 17-21 as unpatentable over Lin and Koike in view of Arita is traversed.

Claims 17-21 are dependent claims, depending directly or indirectly from claim 1, and are therefore patentable over Lin and Koike in view of Arita for at least the same reason. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Arita is cited for the teaching of two light sources in one hand-held unit. However, Arita does not teach a "control unit [that] detects the position of the hand-held device" and therefore the references alone or in combination do not teach each and every element of the claims.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejections to claims 11-16 is requested.

F. Claim 22 was rejected as unpatentable under 35 U.S.C. §103(a) over Lin, Arita and Koike in view of Fitts

The §103(a) rejection of claim 22 as unpatentable over Lin, Arita and Koike in view of Fitts is traversed.

Claim 22 is a dependent claim, depending directly from claim 1, and is therefore patentable over Lin, Arita, and Koike in view of Fitts for at least the same reason. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Fitts is cited for the teaching of using visible light for the light source. However, Fitts does not teach a "control unit [that] detects the position of the hand-held device" and therefore the references alone or in combination do not teach each and every element of the claims.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejection to claim 22 is requested.

G. Claims 24-26 were rejected were rejected as unpatentable under 35 U.S.C. §103(a) over Rice and Koike in view of Kim

The §103(a) rejection of claims 24-26 as unpatentable over Rice and Koike in view of Kim is traversed.

Claims 24-26 are dependent claims, depending directly or indirectly from claim 23, and are therefore patentable over Rice and Koike in view of Kim for at least the same reason. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Neither Rice nor Kim teaches, suggests or discloses a "control unit [that] detects the position of the hand-held device" and therefore the references alone or in combination do not teach each and every element of the claims.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejections to claims 24-26 is requested.

H. Claim 27 was rejected as unpatentable under 35 U.S.C. §103(a) over Rice, Kim, and Koike in view of Fitts

The §103(a) rejection of claim 27 as unpatentable over Rice, Kim and Koike in view of Fitts is traversed.

Claim 27 is a dependent claim, depending indirectly from claim 23, and is therefore patentable over Rice, Kim and Koike in view of Fitts for at least the same reason. See MPEP 2143.03 and In Re Fine (where an independent claim is non-obvious, any claims depending therefrom are also nonobvious.)

Neither Rice nor Kim nor Fitts teaches, suggests or discloses a "control unit [that] detects the position of the hand-held device" and therefore the references alone or in combination do not teach each and every element of the claims.

Since the references do not show or teach or suggest a "control unit [that] detects the position of the hand-held device," Applicants request the Examiner withdraw the rejection. If Examiner wishes to maintain the rejection, Applicants traverse the statement "it would have been obvious ..." and request the Examiner to make a showing in the prior art or in the form of an examiner declaration/affidavit supporting the conclusion that it is well known to provide a control unit that detects the position of a hand-held device. See, MPEP 706.02(a): "If the Applicant traverses such an assertion, the Examiner should cite a reference in support of his/her position." Absent such a showing, Applicants respectfully request allowance of the claims.

Withdrawal of the rejection to claim 27 is requested.

CONCLUSION

The Applicants respectfully submit that claims 1-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: June 30, 2004

Respectfully submitted,
ANTONIO J. COLMENAREZ, *et al.*

PHILIPS IP & STANDARDS
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9665
Fax: (914) 332-0615

Gregory Thorne
Registration No. 39,398
Attorney for Applicants

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113

Frank C. Nicholas
Registration No. 33,983
Attorney for Applicants